

Notice of References Cited form, which accompanied the Office Action. Applicants respectfully request that the Examiner cite Schmidt et al. (U.S. Pat. No. 5,775,280) on a PTO-892 in the next Official Action.

Information Disclosure Statement

The Office Action did not acknowledge receipt and consideration of the Information Disclosure Statement filed April 18, 2005. Applicants respectfully request the Examiner consider the references cited on the PTO-1449 and include an initialed copy of the PTO-1449 with the next official action.

Allowable Subject Matter

Claims 1 and 3-7 were allowed. Claims 10, 13, 16, 19, 22, 25, and 28 were objected to but would be allowable if rewritten in independent form.

Applicants gratefully acknowledge the allowance of claims 1 and 3-7, and the indication of allowable subject matter in claims 10, 13, 16, 19, 22, 25, and 28. However, the objection to claims 10, 13, 16, 19, 22, 25, and 28, is traversed, as these claims depend from allowed claim 7 and, therefore, should also be allowed.

Claim Objections

The Examiner objected to claims 25-27 because the term "caulked" is allegedly inappropriately used. This objection is traversed, and reconsideration and withdrawal thereof respectfully requested.

The Examiner is directed towards the attached copy of the dictionary definition of "caulk." As is clear from the attached definition, "caulked" is properly used in claims 25-27, as the joint at the end of the roller shaft is filled or closed by heat treating the metal.

Claim Rejections Under 35 U.S.C. § 103

Claims 8, 9, 11, 12, 17, 18, 20, 21, 26, 27, 29, and 30 were rejected under 35 U.S.C. 35 § 103(a) as obvious over Brothers (U.S. Pat. No. 6,328,009) in view of Hirakawa et al. (U.S. Pat. No. 6,012,851). The Examiner averred that Brothers substantially discloses the claimed roller cam follower including an outer ring 30, roller shaft 36, and bearing elements 32, 35. The Examiner acknowledged that Brothers does not disclose that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer and a fracture stress of at least 2650 MPa and a hydrogen content of at most 0.5 ppm. The Examiner relied on the teaching of Hirakawa et al. that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer. The Examiner asserted that it would have been obvious to provide a carbonitrided layer in the Brothers device in order to improve physical properties and enhance the longevity of the device. The Examiner stated that "[t]here is no reason to believe Brothers' device as modified . . . wouldn't yield the claimed numerical characteristic values."

Claims 8, 9, 14, 15, 26, 27, 29, and 30 were rejected under 35 U.S.C. 35 § 103(a) as obvious over Faville et al. (U.S. Pat. No. 5,979,383) in view of Hirakawa et al. The Examiner averred that Faville et al. substantially disclose the claimed roller cam follower including an outer ring 42, roller shaft 58, and bearing elements 60. The Examiner acknowledged that Faville et al. do not disclose that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer and a fracture stress of at least 2650 MPa and a hydrogen content of at most 0.5 ppm. The Examiner relied on the teaching of Hirakawa et al. that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer. The Examiner asserted that it would have been obvious to provide a carbonitrided layer in the Brothers device in order to improve physical properties and enhance the longevity of the device. The Examiner stated that

"[t]here is no reason to believe Faville's device as modified . . . wouldn't yield the claimed numerical characteristic values."

Claims 8, 9, 11, 12, 23, 24, 26, 27, 29, and 30 were rejected under 35 U.S.C. 35 § 103(a) as obvious over Bando (JP63-185917) in view of Hirakawa et al. The Examiner averred that Bando substantially disclose the claimed roller cam follower including an outer ring, roller shaft, and bearing elements (Fig. 6). The Examiner acknowledged that Bando does not disclose that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer and a fracture stress of at least 2650 MPa and a hydrogen content of at most 0.5 ppm. The Examiner relied on the teaching of Hirakawa et al. that at least one of the outer ring, roller shaft, and bearing elements has a carbonitrided layer. The Examiner asserted that it would have been obvious to provide a carbonitrided layer in the Bando device in order to improve physical properties and enhance the longevity of the device. The Examiner stated that "[t]here is no reason to believe Bandos' device as modified . . . wouldn't yield the claimed numerical characteristic values."

The obviousness rejections under 35 U.S.C. § 103(a) are traversed, and reconsideration and withdrawal thereof respectfully requested.

Brothers, Faville et al., Bando, and Hirakawa, whether taken in combination, or taken alone, do not suggest the claimed roller cam followers, because the cited references do not suggest that at least one of the outer ring, roller shaft, and bearing elements has a fracture stress of at least 2650 MPa, as required by claim 8, and/or a hydrogen content of at most 0.5 ppm, as required by claim 9. The Examiner has not pointed out any teaching or motivation in the cited references to suggest the fracture stress required by claim 8 and the hydrogen content required by claim 9 in the devices of Brothers, Faville et al., and Bando in view of Hirakawa.

Further, the Examiner did not provide a factual basis to support the allegations that the at least one of the that at least one of the outer ring, roller shaft, and bearing elements of the roller cam followers of Brothers, Faville et al., and Bando in view of Hirakawa would necessarily have a fracture stress of at least 2650 MPa, as required by claim 8, and/or a hydrogen content of at most 0.5 ppm, as required by claim 9. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). "Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citations omitted). Clearly, the Examiner's has not established a prima facie case that the devices of Brothers, Faville et al., Bando, in view of Hirakawa would inherently meet the limitations of claims 8 and 9.

The only teaching of the claimed roller cam followers in which at least one of the outer ring, roller shaft, and bearing elements has a fracture stress of at least 2650 MPa and/or a hydrogen content of at most 0.5 ppm is found in Applicants' disclosure. However, the teaching or suggestion to make a claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Examiner's retrospective assessment of the claimed invention and use of unsupported conclusory statements are not legally sufficient to generate a case of *prima facie* obviousness. The motivation for modifying the prior art must come from the prior art and must be based on facts. The Examiner is not free to ignore the judicial requirement for facts. To do so is legal error. *In re Lee*, 277 F.3d 1338 (Fed. Cir. 2002). It is apparent that

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the Examiner has relied on improper hindsight reasoning in reaching the conclusion of obviousness.

The dependent claims are allowable for at least the same reasons as independent claims 8 and 9 and further distinguish the claimed invention.

In view of the above remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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